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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,684

07/17/2003

Scott A. Waldman

TJU-2858

1770

35148

7590

05/02/2006

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EXAMINER

LIU, SUE XU

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/621,684

Applicant(s)

WALDMAN, SCOTT A.

Examiner

Sue Liu

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 23, 25-28, 30-32, 36, 41 and 42 (see Continuation Sheet).
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 3/27/2006
13. ☐ Other: _____.


ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragraph (written description requirement) rejection over Claims 23, 28, 31, 31, 41, and 42.

Continuation Sheet of Advisory Action**Continuation of 7.**

Applicants have canceled Claims 24, 29, 35, and 37. Therefore, the ODP rejections against the said claims (24, 29, 35 and 37) are withdrawn due to cancellation of the claims. However, the ODP rejections against Claims 23, 25-28, 41 and 42 over US Patents 6,087,109; 5,962,220; and 6,060,037 as well as provisional ODP rejection against Claims 23, 25, 28, 30-32, 36, 41 and 42 over US Patent application 08/468,449 are maintained for the reason of record as set forth in the previously sent office actions. Regarding the ODP rejection over US Patents 6,087,109; 5,962,220; and provisional rejection over US Patent application 08/468,449, applicants state that because no claims have been indicated to be allowable and therefore it is premature to file terminal disclaimers. This is not found persuasive. The claims are not allowable because of the ODP rejections, which can only be overcome with TDs. Because applicants have not filed the TDs to overcome the ODP rejections over these references, the rejections of record have been maintained. Applicants further traversed the ODP rejection over the US Patent 6,060,037. Applicants argue the '037 patent claims are directed to methods of imaging colorectal tumors, in vitro methods of screening individuals, methods of treating colorectal tumors, methods of delivering nucleic acid molecules and kits. And the invention claimed in '037 patent corresponds to the non-elected groups in the present application, and the patent has no claims to conjugated compounds. Applicants' arguments have been fully considered and are not persuasive. Because the original claims in the instant application 10/621,684 are drawn to pharmaceutical compositions, and methods of use of the compositions in in-vivo methods. The independent claims in '037 patent are drawn to 'method of radio imaging metastasized colorectal cancer cells by administering to an individual' (in vivo radio imaging, claim 1); and claim 3 is drawn to 'in vitro method of screening an individual'; claim 5 is drawn to 'in vitro method of determining whether tumor cell is a colorectal tumor cell'; and claim 10 recites a 'kit for determining whether a sample contains a colorectal cancer cell.' And all the '037 patent method claims use the composition of the instant claims. In the instant application (10/621,684) only the methods of use of the compositions comprising 'ST receptor binding ligands' in in-vivo methods were restricted from the compositions comprising 'ST receptor binding ligands.' The instant application does not have 'methods of use of ST receptor binding ligands in vitro. Thus, the obviousness-type double patenting rejection over the '037 patent is proper. In addition, the prohibition against double patenting rejection under 35 U.S.C. 121 is directed against double patenting rejection against a subsequent filed divisional application as a result of the restriction requirement of a parent application. (See MPEP 804.01 [R-3]) In this case, however, applicants are arguing the restriction requirement for the instant application, and comparing the non-elected inventions of the instant

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application with the reference patent. Therefore, the ODP rejections against the said claims are maintained for the reason of record.